



**Content for Talk by Mark Finn and Robert Cain**  
**of emw law llp, Milton Keynes, UK**  
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**Enlargement of European Union**

- 27 Countries but what is the EEA?
- Impact on licensing and distribution



European  
Union:  
27  
Members



## **Registration of IP at European Level**

- EU unitary rights v national rights
- National harmonised rights - Registered Designs, Trade Marks, Databases, Copyright (piecemeal e.g. software, rental rights, duration of protection etc)
- Which are the EU unitary rights? - Just 2! The Community Trade Mark (CTM) and the Community Registered/Unregistered Design
- Where does the European Patent (EP) fit in? - Covers EU? No; but similar coverage. Is it unitary? No; but is unitary up to a point. Translation cost developments - the London agreement.
- Validity and infringement of EU unitary rights
- Central attack of EU unitary rights - tactics
- Validity and infringement of the European Patent
- Central attack of the European Patent

## **EU Community Design Right - some important issues**

- Overlap with trade marks - packaging, get up, graphic symbols (icons and logos)
- Registered v unregistered
- Infringement test

## **5 ways of protecting proprietary designs**

- Copyright - surface decoration and 3D aesthetic works only (sculptures and works of artistic craftsmanship)
- UK Unregistered Design Right - mutually exclusive with copyright
- UK Registered Design
- EU Registered Design
- EU Unregistered Design



## **Recent changes in the law affecting software patents**

- The basic difference between Europe and the USA- software not patentable "as such". But software is patentable if it involves technical means and provides a technical solution to a technical problem
- Format of software claims in Europe: method claims and software for implementing a method
- UK developments re software claims: Macrossan, UKIPO practice note re software claims and Astron Clinica appeal: Court backs non-method software claims
- Effects of Astron Clinica: infringement issues simplified: no need to sue end user or rely on "contributory" infringement (N.B.. territorial issues re "contributory" infringement and increased defences available to contributory infringers)
- Symbian - software patents off to the Court of Appeal again
- Subtle differences between national patent offices and EP Office re tests for patentability of software

## **Transferring Data outside the EEA (Data Protection Directive 95/46/EC)**

- Prohibited unless adequate levels of protection
- USA is not a "safe" country
- Exemptions: consent, safe harbour and model clauses

## **Software Directive and exceptions to the owner's exclusive copyright (Software Directive 91/250/EC)**

- Back up copies
- Observe, Study and Test
- Error Correction
- Decompilation



## **Rights of Licensees to Sue**

- Varies around EU
- Automatic grant (inalienable) –v- Automatic grant (with opt out) –v- opt in
- Exclusive v non-exclusive is the distinction? Not always.
- Patent - UK - automatically inalienable right to take infringement action granted to exclusive licensee only
- Registered Trade Mark – UK
  - “Non-Exclusive” licensee – automatic right of licensee to call upon proprietor to take infringement action – if fails to do so in 2 months, licensee may bring proceedings in own name but such rights can be contractually excluded (opt out)
  - “Exclusive” licensee – Automatic right to take infringement action at its own discretion but this can be contractually excluded (opt out)
- Registered Design - UK – Automatic inalienable right to take infringement action granted to Exclusive Licensee only
- Unregistered Design Right – UK – Automatically inalienable right to bring infringement proceedings granted to Exclusive Licensee only
- Copyright – EU
  - Exclusive Licensee - automatic inalienable right to take infringement proceedings
  - Non-Exclusive Licensee – opt in right to take infringement proceedings

## **Registration of Licences (Applies to Registered Rights Only!)**

- Non-registration of licences may cause the licence to be void against a later purchaser of the IP or anyone else acquiring any conflicting interest in or under it.
- Non-registration may deprive the licensee of costs or other financial relief (in whole or part) against an infringer.



## CONTACT INFORMATION

### MARK FINN

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Mark Finn joined emw law in May 2006, previously having worked for 20 years in international law firms in the City of London.

Mark qualified as a lawyer in 1986 and since then has specialised in Intellectual Property law, both in the field of litigation and commercial contracts.

Mark's litigation experience has included patents, trade secrets/confidentiality, design, copyright and trade marks. He has managed a number of high profile trials in the UK. These have ranged from patent infringements relating to laser eye surgery and circuitry for industrial controls, to copyright infringement relating to psychometric tests and disputes over computer games software.

Mark is an associate member of both the Chartered Institute of Patent Agents and the Institute of Trade Mark Attorneys.

In his spare time, Mark enjoys sub-aqua diving (Mark is a BSAC Advanced Diver), cycling and doing his children's homework

### ROBERT CAIN

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Robert Cain joined emw law's Technology Law Team in June 2002, having previously headed the IT & Commerce department at Kimbells, in Milton Keynes.

Robert qualified as a Solicitor in 1992, having previously gained financial and sales experience with accountants, Price Waterhouse, and then United Biscuits plc.

Robert has worked on a number of large technology projects in the public and private sector. He advises a diverse range of companies on the commercial issues involved in the protection, exploitation, distribution and use of technology and intellectual property at both a national and international level.

When the opportunity arises he likes to watch National Hunt racing and has been known to have the occasional flutter!

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